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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dan McCarthy

Serial No. 76/243,538

Frederick L. Tolhurst of Cohen & Grigsby, P.C. for Dan McCarthy.

John T. Lincoski, Jr., Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Dan McCarthy (applicant) has appealed from the final refusal of the Trademark Examining Attorney to register the mark PANORAMA for windows with vinyl frames.¹ The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 1,313,090, issued January 8, 1985, Section 8 affidavit

¹ Application Serial No. 76/243,538, filed April 20, 2001, based on an allegation of applicant's bona fide intention to use the mark in commerce.

accepted, Section 15 affidavit acknowledged, for the mark shown below

P A N O R A M A

for "patio doors, residential steel doors, door frames, and parts thereof—namely, astragals, molding and trim, all made primarily of metal." Applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

We affirm.

Briefly, the Examining Attorney argues that the marks have the same commercial impression because the minor design elements ("decorative flourish") in registrant's mark are not pronounced and have little trademark significance. Giving greater weight to the arbitrary and dominant element in registrant's mark (the word PANORAMA), the only element pronounced in calling for registrant's goods, the Examining Attorney argues that the respective marks are substantially similar. Because the marks are so similar, the relationship between the goods need not be so close to support a finding of likelihood of confusion,

according to the Examining Attorney. As to the goods, the Examining Attorney has submitted Nexis evidence and copies of third-party registrations in support of his argument that doors and windows are made by some of the same manufacturers and may be sold under the same marks.

According to the Examining Attorney, these closely related goods will be sold in the same channels of trade to the same class of potential purchasers. Also, windows and doors may be installed by the do-it-yourself homeowner at the same time. Finally, the Examining Attorney asks us to resolve doubt in favor of the registrant.

Nine third-party registrations of record show that other companies have registered the same mark for such goods as non-metallic windows and doors, and vinyl and aluminum windows and doors. The Nexis excerpts show a number of references to manufacturers of windows and doors (of unspecified composition) as well as of wood windows and patio doors and aluminum windows and doors.

On the other hand, applicant contends that when the marks are considered in their entirety and not dissected, they have different commercial impressions. In fact, in his brief (3, 5) applicant argues that "the dominant feature is the design" and that "the design is more conspicuous than the accompanying word and has greater

force." See also reply brief, 4 ("...the eye is drawn to the more conspicuous design that prominently appears in the center of the mark..."). Applicant also contends that the goods are noncompetitive and that the comparison here should not be between windows and doors but between vinyl windows and metal or steel doors, and that there are differences in the characteristics (strength, weight, fire resistance, cost, etc.), manufacturing process and application of vinyl and metal or steel products. Applicant also contends that there is no evidence that metal or steel doors are offered in the same channels of trade or to the same purchasers as applicant's vinyl windows.

In response, the Examining Attorney points to two registrations for both vinyl (or non-metal) windows and doors as well as aluminum (or metal) windows and doors, arguing that the same company may make both vinyl or non-metal as well as metal doors and windows.

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that confusion is likely.

Concerning the marks, the correct test is not whether the marks can be distinguished when compared side-by-side, but rather whether the marks at issue create the same

overall commercial impression. The reason for utilizing such a test, as opposed to basing a decision on a side-by-side comparison, is that the latter ordinarily is not the way that customers will be exposed to the respective marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks at issue which must determine, due to the fallibility of memory and the lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is thus on the recollection of the average purchaser, who normally retains only a general rather than a specific impression of marks. See, e.g., *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

The marks here, although not identical, are very similar in appearance and identical in pronunciation and meaning. As the Examining Attorney properly points out, where, as here, a mark consists of a literal portion and a design portion, it is generally the literal portion which is more likely to be impressed upon a consumer's memory and to be used in calling for or asking about the goods. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). Also, there is no indication that the registered mark is other than arbitrary for the goods listed in the registration.

The fact that the respective marks are very similar "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark as a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993). That is to say, "the greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

With respect to the goods, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and the cited registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS*

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Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where an applicant's and a registrant's goods are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods of the nature and type described, but that the identified goods move in all channels of trade which would be normal for those goods and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Further, in order to find likelihood of confusion, it is not necessary that the goods on which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate from the same source or that they are sponsored or approved by the same source. *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001). As the Court of Appeals for the Federal Circuit stated in *Recot, Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000):

[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.

See also *Bose Corporation v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309-1310 (Fed. Cir. 2002) ("Hence the products as described in the pertinent registrations are not the same. But they are related as required by DuPont."); and *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("[E]ven if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

Here, registrant's goods are metal patio and other residential doors while applicant's goods are windows with vinyl frames. The Examining Attorney has made of record evidence that there are third-party manufacturers of both windows and doors, and some manufacturers of both metal and non-metal windows and doors. The evidence is sufficient to conclude that purchasers, aware of registrant's PANORAMA and design mark for metal patio and other residential doors who then encounter applicant's PANORAMA vinyl windows

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(which could also be for residential use) are likely to believe that these goods are made by the same manufacturer or are sponsored or licensed by the same entity.

Decision: The refusal of registration is affirmed.